

DETAILED ACTION

Status of Claims

1. This action is in reply to the application filed on 22 March 2004.
2. Claims 1-6 are currently pending and have been examined.

Information Disclosure Statement

3. The Information Disclosure Statement filed on 22 March 2004 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Drawings

4. The drawings are objected to because examiner is unable to read important fields due to overly greyiness of drawings. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions. Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and the Examiner therefore will treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material. The Examiner recommends *executable computer program, tangibly embodied on a computer-readable medium*.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heise et al. (US PGP 2003/0074229 A1) in view of Grant et al. (Patent No. 5,878,405 A).

10. **Claim 1:**

Heise et al. shown, discloses the following limitations:

- *input routine for accepting input information pertaining to an adopting entity and plan participants* (see at least page 11 paragraph 0146)
- *actuary review routine for formatting information related to said input information, contribution levels and benefit levels and performing certification calculations to facilitate*

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review by an actuary or enrolled actuary (see at least page 6 paragraphs 0081, 0082, 0085 and page 6 Table 12)

- *form generating routine for generating forms and legal documents necessary to implement and maintain the benefit plan* (see at least page 11 paragraph 0148)

Heise et al. does not disclose the following limitations, but Grant et al. however, as shown, does:

- *benefit calculation routine for calculating a contribution level for each plan participant necessary to properly fund the plan and a corresponding benefit level for each plan participant* (see at least column 21 lines 5-16)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the calculation of contributions on different levels in order to determine the proper amount needed to fund selected plan because this would ensure participant gets an adequate return for his/her contributions. "This also provides timely and understandable retirement planning information to make effective retirement related decisions" (see at least column 5 lines 57-59)

11. **Claim 2:**

Heise et al. shown, discloses the following limitations:

- *daily benefit routine that allows a plan participant's benefits to be calculated and output upon request* (see at least page 12 paragraph 0162)

12. **Claim 3:**

Heise et al. shown, discloses the following limitations:

- *communication routine for electronically communicating information to an actuary so that the actuary may prepare and certify the a funded status of the benefit plan* (see page 11 paragraph 0148, 0149)

13. **Claim 4:**

Heise et al. shown, discloses the following limitations:

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- *form generating routine generates at least one of an Adoption Agreement, Resolution Certificate, Plan Prototype, SPD and Beneficiary Designation Form (see at least page 11 paragraph 0148, 0149 and Table 45)*

14. Claim 5:

Heise et al. shown, discloses the following limitations:

- *actuary review routine electronically provides the calculations and supporting data from the benefit plan to the actuary or enrolled actuary for the purpose of preparing and delivering annually the required certification to the Department of Labor (see at least page 11 paragraph 0148)*

15. Claim 6:

Heise et al. shown, discloses the following limitations:

- *plan administrator for tracking contributions made to the plan and tracking assets accumulated in the plan (see at least page 6 paragraph 0085 and Tables 12 and 13)*
- *form generator for generating benefit election forms and benefit statements for participants in the defined benefit plan (see at least page 11 paragraph 0148)*
- *actuary supporter for generating certification data and electronically providing such certification data to an actuary for the purpose of preparing and delivering the required certification for the plan (see at least page 11 paragraph 0148)*
- *generating illustrations that show the required contribution (see at least page 6 paragraph 0085)*

Heise et al. does not disclose the following limitations, but Grant et al. however, as shown, does:

- *plan illustrator for accepting input information pertaining to an entity desiring to implement the defined benefit plan and its employees (see at least column 21 lines 5-16)*
- *calculating a required contribution necessary to fund the plan for a specified time period (see at least column 21 lines 5-16)*
- *estimating benefit levels that the defined benefit plan will deliver and generating required legal forms and documents (see at least column 1 lines 5-16)*

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It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the calculation of contributions on different levels in order to determine the proper amount needed to fund selected plan because this would ensure participant gets an adequate return for his/her contributions. "This also provides timely and understandable retirement planning information to make effective retirement related decisions" (see at least column 5 lines 57-59)

CONCLUSION

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:
- U.S. Patent No. 5,933,815 issued August 3, 1999 to Golden, "Computerized Method And System For Providing Guaranteed Lifetime Income With Liquidity". Reference describes a computerized method and system administering a program to provide a person with guaranteed lifetime benefits/income.

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Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Michael D. Cranford** whose telephone number is **571-272-3106**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James A. Reagan** can be reached at **571-270-6710**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to **571-273-8300**.

Hand delivered responses should be brought to the **United States Patent and Trademark**

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/James A. Reagan/Supervisory Patent Examiner, Art Unit 3621